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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF APPEALS

In re application of)

Robert L. Lundak)

Serial No. 247,656)

Filed: March 26, 1981)

For: HIGH FUSION FREQUENCY)
FUSIBLE LYMPHOBLASTOID)
CELL LINE)

Examiner: J. Tarcza

Art Unit: 172

REPLY BRIEF

588-11

San Francisco, CA 94105

Commissioner of Patents and Trademarks

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Washington, D.C. 20231

APR 20 1984

Sir:

BOARD OF APPEALS

A response to the Examiner's Answer is believed necessary in view of certain misconstructions of the basis for the present appeal.

(1) The rejection is characterized as, "The sole issue in this case is whether the disclosure must be enabling as of the filing date or as of the issued date."

It is submitted that this mischaracterizes the sole issue, if indeed there is a sole issue. First, the question is enabling as to whom. The disclosure is certainly enabling as to the applicant who has the organism. The question then is not whether the disclosure teaches how to practice the invention, but whether the applicant has removed from his dominion an essential aspect of the enabling disclosure. The policy considerations should not revolve around the enabling requirement of §112, but whether there is a public interest in requiring an applicant to release materials to an independent depository at a time

Mr. Reply deemed necessary
3/29/84

when there is no certainty of a patent issuing, nor statutory authority nor good reason why such release should be required.

It is a sad fact that historically the Patent Office has taken a cynical view of applicants. The requirement for corroboration in interference practice, the frequency with which declarations by applicants have been viewed with disfavor by the Appellant Tribunal, the requirement that an applicant remove co-authors as potential co-inventors, and now the requirement for deposit, indicates an attitude of distrust on the part of the Patent and Trademark Office of an applicant's bona fides. Rather than waiting until the applicant is assured of receiving a patent, the PTO adds an unnecessary and additional burden to a particular class of applicants, because of a desire for certainty that the subject matter exists. This is directly contrary to the notion of a constructive reduction to practice.

(2) The second issue is believed to be a mischaracterization of the fact situation of Feldman v. Aunstrup, 186 USPQ 108 (CCPA 1975).

Reliance on White Consolidated Industries, Inc. v. Vega Servo-Control, Inc., 218 USPQ 961 (CAFC 1983) is submitted to be misplaced. In that decision, the concern was about a description of a specific piece of equipment which was essential to the invention. The Court found that such equipment could only be developed by undue experimentation and, therefore, the disclosure was not enabling. However, in the subject situation the application is not concerned with a piece of equipment, but rather an organism which is completely described in the application

and defined as to its properties. The primary concern is that when the patent issues the organism will be available to the public to practice the invention. The rule has been clear for a long time that where there is an essential element which can be described in words in the application, the applicant is required to describe such element, both for enablement and best mode purposes. The statute specifically provides that there be a writing which includes this information. The subject situation is distinguished by the fact that we are not concerned with a writing, but rather a live organism.

The Feldman decision held that the Argoudelis requirements were not mandatory, but rather sufficient. While in Feldman, Aunstrup did deposit the organism in a depository, the fact remains that the deposit was not made under the Argoudelis conditions, that is, there was no assurance that the cell line would be available as of when a patent issued, and the cell line remained for all intents and purposes under the applicant's dominion and control. The Court in Feldman solely looked to the fact that there was assurance that the cell line would be available at such time as a patent issued, in that it could be maintained in viable form by the depository. The Examiner has indicated that a statement made by applicant's attorney, "Aunstrup had failed to deposit a microorganism at a depository consistent with the requirements set forth in Argoudelis and MPEP 608.01(p)" was "both misleading and incorrect." The Honorable Board's attention is directed to 186 USPQ 111, where it is stated, "Dr. DeVries stated that such cultures are maintained as a part of the permanent collection, but

are made available to third parties only after written consent is given to CBS by the depositor."

Furthermore, the Court stated 186 USPQ, at 113:

"The gravamen of Feldman's argument pertains to another function of §112, first paragraph--that of assuring public access to an essential starting material (the microorganism) in the recited process. This is analogous to the complete public disclosure function of §112, first paragraph, and that function is only violated if the disclosure is not complete at the time it is made public, i.e., at the issue date."

The Court then went on to say that during the pendency of the application, the restrictions on access were removed and the culture made open to the public.

It is therefore believed that the Examiner may have misconstrued the difference between the restricted deposit as we understand it in the United States and a restricted deposit as it related to the deposit in the foreign depository.

Finally, in view of the Examiner's statement that the only issue is whether the disclosure needs to be enabling as of the filing date, the Examiner's attention is directed to the above-quoted paragraph in the Feldman decision.

So far as the notice of the ATCC deposit, it is believed to be proper since this is the place where the organism will be available as and when the subject patent application issues as a patent. It should not be necessary to state where the organism was retained at the time of filing, since that is not relevant to the issue of enablement at the time of issuance.

Applicant agrees with the Examiner, in part, that it would probably be difficult to duplicate the identical cell line prepared by the inventor. However, it is not

clear that it would be difficult to produce a cell line, which for all intents and purposes would have the same properties as the cell line of the subject application. However, for the purposes of this appeal, it is believed unnecessary to elaborate on such arguments.

For the reasons given above as well as in the original brief, the Honorable Board is respectfully requested to reverse the Examiner.

Respectfully submitted,

TOWNSEND and TOWNSEND

Date 3/9/84

By Bertram I. Rowland
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BIR/gs

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Date 3/9/84 By TOWNSEND & TOWNSEND
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